

UNITED STATES DISTRICT COURT

DISTRICT OF MAINE

BENCHMARK,

Plaintiff

v.

BENCHMARK BUILDERS, INC.,

Defendant

Civil No. 00-151-P-H

***RECOMMENDED DECISION ON CROSS-MOTIONS
FOR SUMMARY JUDGMENT***

Plaintiff Benchmark and defendant Benchmark Builders, Inc. cross-move for summary judgment as to the plaintiff's entire five-count complaint, encompassing a claim for trademark-infringement pursuant to the Lanham Act, 15 U.S.C. § 1125(a), and four pendent state-law claims. *See generally* Motion for Summary Judgment, etc. ("Defendant's Motion") (Docket No. 6); Plaintiff's Motion for Summary Judgment, etc. ("Plaintiff's Motion") (Docket No. 8); Complaint (Docket No. 1).

For the reasons that follow, I recommend that the defendant's motion be granted and that of the plaintiff be denied.¹

I. Summary Judgment Standards

Summary judgment is appropriate only if the record shows “that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.” Fed. R. Civ.

¹ The defendant also moves for a hearing on its motion for summary judgment. Motion for Hearing on Defendant's Motion for Summary Judgment (Docket No. 7). Inasmuch as the parties' papers provide a sufficient basis on which to decide the motions, the request is denied.

P. 56(c). “In this regard, ‘material’ means that a contested fact has the potential to change the outcome of the suit under the governing law if the dispute over it is resolved favorably to the nonmovant By like token, ‘genuine’ means that ‘the evidence about the fact is such that a reasonable jury could resolve the point in favor of the nonmoving party’” *McCarthy v. Northwest Airlines, Inc.*, 56 F.3d 313, 315 (1st Cir. 1995) (citations omitted).

The party moving for summary judgment must demonstrate an absence of evidence to support the nonmoving party’s case. *Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986). In determining whether this burden is met, the court must view the record in the light most favorable to the nonmoving party and give that party the benefit of all reasonable inferences in its favor. *Cadle Co. v. Hayes*, 116 F.3d 957, 959 (1st Cir. 1997). To the extent that parties cross-move for summary judgment, the court must draw all reasonable inferences against granting summary judgment to determine whether there are genuine issues of material fact to be tried. *Continental Grain Co. v. Puerto Rico Maritime Shipping Auth.*, 972 F.2d 426, 429 (1st Cir. 1992). If there are any genuine issues of material fact, both motions must be denied as to the affected issue or issues of law; if not, one party is entitled to judgment as a matter of law. 10A C. Wright, A. Miller & M. Kane, *Federal Practice and Procedure* § 2720, at 336-37 (1998).

II. Factual Context

The contours of facts cognizable for purposes of summary judgment in this case are shaped in large part by the defendant’s substantial non-compliance with Local Rule 56. Local Rule 56 requires the filing of three separate documents in addition to the parties’ motions and memoranda of law — to wit, supporting, opposing and reply statements of material facts, each of which must contain numbered paragraphs and within which (per subsection (e)) each asserted fact must be “followed by a citation to the specific page or paragraph of identified record material supporting the assertion.” Loc. R. 56.

Both the opposing and reply statements must admit, deny or qualify, by reference to specific paragraph, the facts set forth in the statements of material fact to which they respond. *Id.* Denials or qualifications must be supported by specific, supporting record citations. *Id.*

A party fails to honor this rule at its peril. *See* Loc. R. 56(e) (“Facts contained in a supporting or opposing statement of material facts, if supported by record citations as required by this rule, shall be deemed admitted unless properly controverted. . . . The court may disregard any statement of fact not supported by a specific citation to record material properly considered on summary judgment.”); *Pew v. Scopino*, 161 F.R.D. 1, 1 (D. Me. 1995) (“The parties are bound by their [Local Rule 56] Statements of Fact and cannot challenge the court’s summary judgment decision based on facts not properly presented therein.”).

The defendant in this case submits no separate statement of material facts either in support of its own motion for summary judgment or in opposition to that of the plaintiff. It does submit briefs containing separately titled fact sections; however, it strays outside even of those boundaries, sprinkling asserted facts (some unsupported by record citations) throughout the body of those documents. *See generally* Defendant’s Motion; Defendant’s Opposition to Plaintiff’s Motion for Summary Judgment, etc. (“Defendant’s Opposition”) (Docket No. 10). The plaintiff responds to the separately titled fact section contained in the Defendant’s Opposition, *see generally* Plaintiff’s Reply Statement of Material Facts (“Plaintiff’s Reply SMF”) (Docket No. 15), but declines to respond to the “spillover” facts — a task that it contends exceeds the bounds of its obligations under Local Rule 56, *see* Plaintiff’s Statement of Material Facts in Opposition to Defendant’s Statements of Material Fact as to Which There Is No Genuine Issue To Be Tried (“Plaintiff’s Opposing SMF”) (Docket No. 12) at 1.²

² The plaintiff does not respond to the defendant’s separately titled five-sentence statement of facts supporting the defendant’s own motion. *See* Defendant’s Motion at 1; Plaintiff’s Opposing SMF. I nonetheless disregard it inasmuch as three sentences lack any supporting record citation; a fourth sentence, explaining why the defendant picked the name “Benchmark,” is not supported by the (continued on next page)

The line is appropriately drawn at the “spillover” facts. The strewing of asserted facts throughout the body of a brief contravenes not only the letter but also the spirit of the rule, key purposes of which are to focus the issues and to conserve the time of counsel and the court.

The plaintiff, for its part, on certain occasions omits details from its statements of material facts to which it adverts via its record citations. *See, e.g.*, Plaintiff’s Statement of Material Facts as to Which There Is No Genuine Issue To Be Tried (“Plaintiff’s SMF”) (Docket No. 9) ¶¶ 12 (omitting to set forth affiant’s title or connection to plaintiff), 13 (omitting details of four instances of confusion). Details omitted from a statement of material facts do not form a part of the summary-judgment record. *See, e.g., CMM Cable Rep., Inc. v. Ocean Coast Props., Inc.*, 888 F. Supp. 192, 201 n.7 (D. Me. 1995), *aff’d*, 97 F.3d 1504 (1st Cir. 1996) (“Under [Local Rule 56], it is not the court’s duty to go beyond the parties’ statements of material facts. . . . The parties are bound by their [Local Rule 56] Statements of Fact and the court’s summary judgment decision will be based solely upon facts properly presented therein.”).

With the defendant’s “spillover” facts disregarded, and other facts deemed admitted to the extent not properly controverted and supported by record citations in accordance with Local Rule 56, the following comprise the statements of fact material to this recommended decision:

The plaintiff, a corporation doing business in Maine and New Hampshire, primarily provides commercial construction services. Plaintiff’s SMF ¶¶ 1, 3. The plaintiff began using the mark “Benchmark” in 1993 in connection with commercial construction services. *Id.* ¶ 2. The plaintiff uses the mark “Benchmark” in commerce. *Id.* ¶ 4.

The defendant, which has a principal place of business in Brunswick, Maine, was incorporated in Maine in 1998 and has been engaged in the construction business in Maine since that time. *Id.* ¶¶ 5,

record citation given; and the fifth sentence, explaining why the plaintiff chose the name “Benchmark,” is irrelevant.

7. The defendant began using the mark “Benchmark Builders” in connection with its construction business in 1998. *Id.* ¶ 6.³ Since 1998, the defendant has performed numerous commercial construction jobs in Maine, including the construction of a Friendly’s Restaurant in Ellsworth, Maine and renovations to the Kennebunk Police Station in Kennebunk, Maine. *Id.* ¶ 8; Defendant’s Opposition ¶ 2.⁴ The defendant has promoted its construction company through radio advertising on WXGL-95.5 F.M., now known as WCLZ. Plaintiff’s SMF ¶ 9. Suzanne J. Telfeian, owner and president of Pine Tree Property Management, Inc. of Bridgton, Maine, heard radio advertisements for the defendant on several occasions believing them to be advertisements for the plaintiff. *Id.* ¶ 11. James Harford has on several occasions seen the defendant’s advertisements and signs in the Brunswick, Maine area and believed them to be advertisements for the plaintiff. *Id.* ¶ 12.

The defendant is aware of four instances of actual confusion between the plaintiff’s mark and defendant’s “Benchmark Builders” business since 1998, involving the following businesses: Builders Insulation, Kamco, Applicators and Hardypond Construction. *Id.* ¶ 13.

The mark “Benchmark” is understood in Maine to refer exclusively to Mark Woodward’s construction company Benchmark. *Id.* ¶ 14.⁵

³ There is conflicting evidence as to the date on which the defendant actually began using the “Benchmark” name. The defendant adduces evidence that its president, John Theriault, began using the term on construction signs as early as 1995 and on a business checking account as early as 1996. Defendant’s Opposition ¶ 1. The plaintiff denies this assertion, noting that the defendant admitted in answering the Complaint that it began using the mark in connection with its construction business in 1998 and that in Theriault’s tax returns for 1996 and 1997 he listed his business name as “John A. Theriault.” Plaintiff’s Reply SMF ¶ 1. Nothing turns on resolution of this issue inasmuch as, under either scenario, the plaintiff remains the senior user of the mark.

⁴ The defendant functioned as a subcontractor on the Friendly’s and Kennebunk Police Station jobs. Defendant’s Opposition ¶ 2. According to the defendant’s brochure, it also functions as a general contractor. Plaintiff’s Reply SMF ¶ 2.

⁵ The defendant denies this statement, asserting that (i) eighteen companies in Maine use the name “Benchmark,” (ii) a web site, www.contractors.com, lists one hundred and two companies with the name “Benchmark” and (iii) Jamie Cook testified at deposition that an internet domain-name search revealed approximately 8,000 users. Defendant’s Opposition ¶ 4. As pointed out by the plaintiff, the proffered evidence is inadmissible. *See* Plaintiff’s Reply SMF ¶ 4; Plaintiff’s Reply to Defendant’s Opposition to Plaintiff’s Motion for Summary Judgment, etc. (“Plaintiff’s Reply”) (Docket No. 14) at 2-5. The defendant offers the affidavit of Diane Porter, a legal assistant for defense counsel, for the propositions that (per her contact with the Bureau of Corporations in Augusta, Maine) eighteen companies using the name “Benchmark” are incorporated in Maine and (per her internet search) the web site www.contractors.com lists one hundred and two companies that use the name “Benchmark.” *See* Affidavit [of Diane F. Porter], attached as Exh. A to Defendant’s Motion (“Porter Aff.”). Porter’s statement regarding the Bureau of Corporations is inadmissible hearsay. She does not
(continued on next page)

The plaintiff and the defendant both advertise through the use of signs at job sites and the distribution of stationery, brochures and small promotional items. *Id.* ¶ 15. The defendant has used the United States Postal Service to solicit business throughout southern Maine by mailing form letters advertising its construction business. *Id.* ¶ 16.

III. Discussion

A. Count I: Lanham Act/Trademark Infringement

A senior user of an unregistered mark prevails on a claim of trademark infringement pursuant to the Lanham Act upon demonstrating that (i) its mark is inherently distinctive or, if merely descriptive, has acquired distinctiveness through secondary meaning and (ii) there is a substantial likelihood of confusion. *See, e.g., Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768-69 (1992); *Commerce Nat'l Ins. Servs., Inc. v. Commerce Ins. Agency, Inc.*, 214 F.3d 432, 438 (3d Cir. 2000) (“With respect to ownership of an unregistered mark, the first party to adopt a mark can assert ownership so long as it continuously uses the mark in commerce.”) (citation and internal quotation marks omitted).⁶ The plaintiff in this case clears the first hurdle but falters at the second.

purport to be an employee of that agency, and no authenticated agency document is provided. Moreover, the mere registration or listing of a name is immaterial in this context; only actual usage matters. *See, e.g., Jordache Enters., Inc. v. Levi Strauss & Co.*, 841 F. Supp. 506, 516 n.11 (S.D.N.Y. 1993) (“[m]ere registrations, by themselves, prove neither actual use of any of the marks registered by competitors, nor the degree of competitors' promotion of their marks through advertising”) (citation and internal quotation marks omitted). The internet printout (a copy of which is appended to Porter's affidavit) likewise is irrelevant. Not only is it a mere listing (and thus not probative of actual usage) but it also happens to list only one Maine company. *See* Exh. A to Porter Aff. The Cook testimony is not only irrelevant, in that it adverts to a mere listing, but is also hearsay. Cook apparently did not herself perform the domain-name search, the nature of which is unclear from her deposition testimony. *See* Deposition of Jamie Cook, filed with Defendant's Opposition, at 38.

⁶ Although there is no evidence that the defendant has undertaken construction projects outside of Maine, the plaintiff asserts that it (plaintiff) does business interstate and has been harmed by the alleged infringement. Complaint ¶¶ 7, 16-18. This suffices to establish federal-question jurisdiction pursuant to the Lanham Act. *See PCS 2000 LP v. Romulus Telecomms., Inc.*, 148 F.3d 32, 34 (1st Cir. 1998) (“It is settled beyond peradventure that a federal court must determine the existence of federal question jurisdiction according to the well-pleaded complaint rule. The rule stipulates that, with few exceptions (none applicable here), a case arises under federal law only if a federally cognizable cause of action appears within the four corners of the complaint.”) (citations omitted); *Purolator, Inc. v. EFRA Distribs., Inc.*, 687 F.2d 554, 559 (1st Cir. 1982) (“[A]n adverse effect on the sales or goodwill of one whose trademark is used in interstate commerce is a sufficiently substantial effect on interstate commerce to entitle the registrant to invoke the protection of the Lanham Act, even if the sales of the defendant are wholly intrastate.”); *Mother Waddles Perpetual Mission, Inc. v. Frazier*, 904 F. Supp. 603, 611 (E.D. Mich. 1995) (“[E]ven if the infringer's business is maintained within one state, (continued on next page)

The Supreme Court has described a five-step continuum from least to most distinctive type of mark: “(1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.” *Two Pesos*, 505 U.S. at 768. “The latter three categories of marks, because their intrinsic nature serves to identify a particular source of a product, are deemed inherently distinctive and are entitled to protection.” *Id.* The defendant contends that the plaintiff’s mark is merely descriptive; the plaintiff asserts that it is at least suggestive. Defendant’s Motion at 2-3; Plaintiff’s Motion at 4.

The word “bench mark” is defined to mean: “**1**: a mark on a fixed and enduring object (as on an outcropping of rock or a concrete post set into the ground) indicating a particular elevation and used as a reference in topographical surveys and tidal observations **2** *usu* **benchmark** . . . : a point of reference from which measurements of any sort may be made” Webster’s Third New International Dictionary 203 (1981).

The mark “Benchmark” is not descriptive of commercial-construction services. *See Wiley v. American Greetings Corp.*, 762 F.2d 139, 141 n.3 (1st Cir. 1985) (“A mark is ‘descriptive’ if it is descriptive of: the intended purpose, function or use of the goods; of the size of the goods, of the class of users of the goods, of a desirable characteristic of the goods, or of the end effect upon the user.”) (citation and internal quotation marks omitted). The mark has a tangential connection to construction (in which, one would surmise, topographical surveys and other types of benchmarks are used), making it arguably “suggestive.” *See Equine Techns., Inc. v. Equitechnology, Inc.*, 68 F.3d 542, 545 (1st Cir. 1995) (mark “Equine Technologies” suggestive, but not descriptive, of hoof pads for horses). More likely, given the tenuousness of the connection, the mark is “arbitrary.” *See Wiley*, 762 F.2d at 141 n.2 (“‘Arbitrary’ marks are words, symbols, pictures, etc., which are in common linguistic use but which, when used with the goods or services in issue, neither suggest nor describe any ingredient,

where the trademark owner’s business is interstate and he alleges damage to the mark, the interstate commerce requirement is met.”).

quality, or characteristic of those goods or services.”) (citation and internal quotation marks omitted).

Whether classed as “suggestive” or “arbitrary,” the mark “Benchmark,” used in connection with commercial construction services, is inherently distinctive.

To establish likelihood of confusion, a mark holder must show “that the allegedly infringing conduct carries with it a likelihood of confounding an appreciable number of reasonably prudent purchasers exercising ordinary care.” *International Ass’n of Machinists v. Winship Green Nursing Ctr.*, 103 F.3d 196, 201 (1st Cir. 1996). Eight factors typically are relevant to this assessment, three of which (the third through fifth) generally are considered together:

(1) the similarity of the marks; (2) the similarity of the goods (or, in a service mark case, the services); (3) the relationship between the parties’ channels of trade; (4) the juxtaposition of their advertising; (5) the classes of prospective purchasers; (6) the evidence of actual confusion; (7) the defendant’s intent in adopting its allegedly infringing mark; and (8) the strength of the plaintiff’s mark.

Id. at 201, 204. “No one listed factor is determinative, and any other factor that has a tendency to influence the impression conveyed to prospective purchasers by the allegedly infringing conduct may be weighed by the judge or jury in gauging the likelihood of confusion.” *Id.* at 201. “The eight-factor confusion test is not applied to assess confusion in the abstract; it is focused on the likelihood that commercially relevant persons or entities will be confused.” *CMM Cable*, 888 F. Supp. at 200. “Actual and potential customers of the trademark owner are the most obvious ‘relevant persons,’ but other persons might be relevant in a given case.” *Id.*

Applying these factors to the case at hand, the record reveals that:

1. The key word in both marks — “Benchmark” — is identical in sound and spelling.⁷

This counsels in favor of a finding of likelihood of confusion.

⁷ I am mindful that, in considering the similarity of trademarks the court is “to consider the mark as a whole.” *See, e.g., Best Flavors, Inc. v. Mystic River Brewing Co.*, 886 F. Supp. 908, 913 (D. Me. 1995). However, neither the plaintiff nor the defendant includes a reference to visual representations of either mark in its statement of material facts, nor does either argue that such representations are (continued on next page)

2. Both parties use the mark in connection with commercial construction services. This again counsels in favor of a finding of likelihood of confusion.

3. Both parties undertake such projects in Maine. Both advertise through signs at job sites and the distribution of stationery, brochures and small promotional items. The record is otherwise notable for its silence regarding the parties' clientele, the manner in which commercial-construction services are purchased and the price charged for such services. These omissions are troubling inasmuch as "the requisite inquiry is not limited merely to determining whether the class of prospective purchasers is the same or different. Instead, a court called upon to assay likelihood of confusion must ponder the sophistication of the class, thereby taking account of the context in which the alleged infringer uses the mark." *Winship Green*, 103 F.3d at 204. The complete failure of proof on this vitally important point cuts against the plaintiff, which bears the ultimate burden of proof and persuasion in pressing its claims. In any event, commercial construction self-evidently is costly, and one reasonably could infer that the choice of a builder or contractor would tend not be hastily or lightly made. *See Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206 (1st Cir. 1983) ("[T]here is always less likelihood of confusion where goods are expensive and purchased after careful consideration. . . . The decision to buy a machine worth thousands of dollars is obviously not done on an impulse, and involves a careful consideration of the reliability and dependability of the manufacturer and seller of the product."); *Best Flavors*, 886 F. Supp. at 916 (observing that the kind of "sophisticated purchaser" that courts have in mind when analyzing likelihood of confusion is one with "experience in purchasing a product and who care[s] about [its] purchase decisions; typically, 'high

relevant to its claim or defense. *See generally* Defendant's Motion; Defendant's Opposition; Defendant's Reply to Plaintiff's Opposition to Defendant's Motion for Summary Judgment (Docket No. 13); Plaintiff's Motion; Plaintiff's SMF; Plaintiff's Opposition to Defendant's Motion for Summary Judgment, etc. (Docket No. 11); Plaintiff's Opposing SMF; Plaintiff's Reply; Plaintiff's Reply SMF.

ticket’ items are involved.”).⁸ Consideration of these factors on the whole militates against a finding of likelihood of confusion on the part of relevant persons (purchasers, prospective purchasers and those who would influence purchasing decisions, such as architects and real-estate agents) at point of purchase — although, in view of the similarity of the mark and services rendered, initial or temporary confusion among even sophisticated purchasers would be likely.

4. Two persons, neither of whose connection to the plaintiff is described in the plaintiff’s statement of material facts, aver that they assumed that radio or job-site advertisements of the defendant were those of the plaintiff. The defendant is said to have been aware of four other instances of confusion, the details of which are not set forth in the plaintiff’s statements of material facts or the defendant’s separately titled fact sections. While there thus is some evidence of actual confusion, there is no evidence of actual confusion on the part of relevant persons. Inasmuch as “[e]vidence of actual confusion is not invariably necessary to prove likelihood of confusion,” *Pignons, S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 490 (1st Cir. 1981), this factor is neutral.⁹

5. There is no evidence regarding the defendant’s intent in picking the name “Benchmark.” This cuts against a finding of likelihood of confusion.

⁸ The plaintiff contends that, even assuming *arguendo* that purchasers of commercial-construction services are “sophisticated,” this trait does not necessarily mean that they are less likely to be confused. Plaintiff’s Motion at 11. For this proposition it cites two cases. *Id.* The first, *Krueger Int’l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 611 (S.D.N.Y. 1996), is distinguishable inasmuch as it refers to the propensity of certain “sophisticated” buyers, because of their awareness of and thirst for “prestige” or “status”-type labels, to be more (rather than less) confused by products with similar-sounding labels. The point made in the second case cited is well taken— that “where the products are identical and the marks are identical, the sophistication of buyers cannot be relied on to prevent confusion.” *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1137 (2d Cir. 1979), *superseded by rule on other grounds as stated in Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033 (2d Cir. 1992). In this case the similarity of name and identical nature of service argue strongly in favor of a finding of likelihood of at least initial or temporary confusion, but do not compel a conclusion that buyers are confused at point of purchase — something that, in view of the absence of evidence regarding the sophistication of purchasers and the inherent nature of the service in issue, I am unwilling simply to assume.

⁹ Absence of actual evidence of confusion is prejudicial in cases in which goods or services have been marketed side-by-side for a substantial period of time and the goods or services of the parties have other substantial disparities. *See, e.g., Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 818 (1st Cir. 1987). The parties’ statements of material facts reveal no substantial disparities between the parties’ services.

6. “To assess the strength of a mark, one considers its distinctiveness or renown, the length of time it has been used, whether similar marks are in use, and the plaintiff’s actions in promoting its mark.” *CMM Cable*, 888 F. Supp. at 201. The plaintiff’s mark is moderately strong, based on evidence of its association with the plaintiff’s business, its seven years of use, lack of evidence of the use of similar marks (apart from that of the defendant) and the inherently distinctive (suggestive or arbitrary) nature of the mark. On the other hand, there is no evidence of a significant investment of time or money in the promotion of the name. While this factor on the whole leans in favor of a finding of likelihood of confusion, “the muscularity of a mark, in and of itself, does not relieve the markholder of the burden to prove a realistic likelihood of confusion.” *Winship Green*, 103 F.3d at 206.

Stepping back from the detail of the eight factors, I find that, in view of the use of a nearly identical mark for a nearly identical service and the relative strength of the plaintiff’s mark, relevant persons likely would be initially or temporarily confused by the juxtaposition of the two service marks.

So-called “initial interest confusion” has been recognized as actionable under the Lanham Act in other circuits. *See, e.g., Brookfield Communications, Inc. v. West Coast Entm’t Corp.*, 174 F.3d 1036, 1062 (9th Cir. 1999) (“[T]he use of another’s trademark in a manner calculated to capture initial consumer attention, even though no actual sale is finally completed as a result of the confusion, may be still an infringement.”) (citation and internal quotation marks omitted); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 204 (5th Cir. 1998) (“Actual confusion that is later dissipated by further inspection of the goods, services, or premises, as well as post-sale confusion, is relevant to a determination of a likelihood of confusion.”). However, the First Circuit, while not expressly rejecting the doctrine of initial-interest confusion, has indicated that confusion must be found likely at

point of purchase to be actionable under the Lanham Act. *See Astra*, 718 F.2d at 1207 (“There is no evidence that any temporary confusion that may have occurred regarding the identity of the salesmen had any effect whatever on the ultimate decision of a purchaser whether to buy a particular product.”); *see also Star Fin. Servs., Inc. v. Aastar Mortgage Corp.*, 89 F.3d 5, 9 (1st Cir. 1996) (“Confusion about source exists when a buyer is likely to purchase one product in the belief she was buying another and is thus potentially prevented from obtaining the product she actually wants.”).¹⁰

The plaintiff has established neither actual confusion at point of purchase nor the likelihood of such confusion, in view of (i) the striking absence of evidence concerning the manner in which the parties’ services are purchased and the nature of their clientele and (ii) the self-evidently costly nature of such services (leading to a reasonable inference that great care would be taken in identifying the correct contractor at point of purchase).¹¹ The defendant accordingly is entitled to summary judgment as to Count I.

B. Counts II-V: Pendent State-Law Claims

The plaintiff in Counts II-V alleges violation of the Maine anti-dilution statute, 10 M.R.S.A. § 1530 (Count II), violation of the Maine deceptive trade-practices act, 10 M.R.S.A. § 1212 (Count III),

¹⁰ The plaintiff argues that *Astra* has been misconstrued as constituting a rejection of the “initial interest confusion” doctrine, a proposition for which it cites two District of Massachusetts cases, *EMC Corp. v. Hewlett-Packard Co.*, 59 F. Supp.2d 147 (D. Mass. 1999), and *Big Top USA, Inc. v. Wittern Group*, 998 F. Supp. 30 (D. Mass. 1998), *abrogated on other grounds by I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27 (1st Cir. 1998). Plaintiff’s Motion at 13 n.2. In *EMC*, Judge Tauro did indeed note: “Given that a number of circuits have endorsed the theory, the First Circuit would likely have spent more time discussing the issue had it intended to expressly reject the theory.” *EMC*, 59 F. Supp.2d at 150 (footnote omitted). And in *Big Top*, Judge Saris rejected a claim of initial-interest confusion on its merits after observing: “True, the Lanham Act forbids a competitor from luring potential customers from a producer by initially passing off its goods as those of the producer’s, even if confusion as to the source of the goods is dispelled by the time any sales are consummated.” *Big Top*, 998 F. Supp. at 52 (citation and internal quotation marks omitted). However, another judge of the District Court for the District of Massachusetts, Judge Woodlock, has subsequently observed (albeit in dictum) that “initial confusion . . . is not cognizable under trademark law in the First Circuit.” *Northern Light Techn., Inc. v. Northern Lights Club*, 97 F. Supp.2d 96, 113 (D. Mass. 2000).

¹¹ This is not to say that a plaintiff cannot possibly make out a case of trademark infringement in a case in which a high-cost item or service and/or particularly discerning buyers are involved. *See Aastar*, 89 F.3d at 10 (noting that, although argument that mortgage shoppers were highly sophisticated and exercised great care in choosing mortgages was “not without force,” jury could have found that such evidence was not overwhelmed by bulk of other evidence suggestive of confusion). The plaintiff on this record does not make out such a case.

common-law unfair competition (Count IV) and common-law trademark infringement (Count V). Complaint ¶¶ 21-45. The plaintiff indicates that Lanham Act analysis applies to all but a portion of Count II asserting diminution in the uniqueness and individuality of its mark. Plaintiff’s Motion at 14-16. The defendant applies a Lanham Act type of analysis to all pendent state-law claims except for Count IV (alleging unfair competition), which it asserts requires a showing of intent to deceive. Defendant’s Motion at 4-6; Defendant’s Opposition.

To the extent that the parties’ state-law arguments overlap those made in the context of the Lanham Act, I resolve those claims (Counts III, V and that portion of Count II alleging violation of the anti-dilution statute based on a theory of confusion) in the same manner as the federal claim.

Turning to the remaining portion of Count II, in the absence of Maine caselaw construing the anti-dilution statute this court has applied the interpretation given a parallel Massachusetts statute by the First Circuit in *Pignons*. See, e.g., *Best Flavors*, 886 F. Supp. at 918. As the First Circuit made clear in *Pignons*, a plaintiff cannot succeed on a theory of diminution in uniqueness and individuality of its mark when the mark in question — however distinctive for Lanham Act purposes — “is virtually a household word.” *Pignons*, 657 F.2d at 495. The term “benchmark” is, if anything, more commonplace than the word “alpha” at issue in *Pignons*.

Turning to Count V, the defendant correctly observes that a showing of intent to deceive is essential to a claim of common-law unfair competition. See Defendant’s Motion at 6; *Hubbard v. Nisbet*, 159 Me. 406, 407 (1963) (“The underlying element in all (definitions of unfair competition) is that no person shall be permitted to palm off his own goods or products as the goods or products of another. . . . The ground of the action is fraud.”) (citation and internal quotation marks omitted). No such showing is made here.

IV. Conclusion

For the foregoing reasons, I recommend that the Defendant's Motion be **GRANTED** and the Plaintiff's Motion be **DENIED**.

NOTICE

A party may file objections to those specified portions of a magistrate judge's report or proposed findings or recommended decisions entered pursuant to 28 U.S.C. § 636(b)(1)(B) for which de novo review by the district court is sought, together with a supporting memorandum, within ten (10) days after being served with a copy thereof. A responsive memorandum shall be filed within ten (10) days after the filing of the objection.

Failure to file a timely objection shall constitute a waiver of the right to de novo review by the district court and to appeal the district court's order.

Dated this 29th day of December, 2000.

*David M. Cohen
United States Magistrate Judge*

TRLIST STNDRD

U.S. District Court
District of Maine (Portland)

CIVIL DOCKET FOR CASE #: 00-CV-151

BENCHMARK v. BENCHMARK BUILDERS
Assigned to: JUDGE D. BROCK HORNBY
Demand: \$0,000
Lead Docket: None

Filed: 05/19/00

Nature of Suit: 840
Jurisdiction: Federal Question

Cause: 15:1125 Trademark Infringement (Lanham Act)

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